

11-07-02

#9

2176\$

PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number

09/866,425

Filing Date

May 24, 2001

First Named Inventor

Vilcauskas et al.

Group Art Unit

2176

Examiner Name

Total Number of Pages in This Submission

16

Attorney Docket Number

Exit:PostSes

## ENCLOSURES (check all that apply)

☒ Fee Transmittal Form (in duplicate)☐ Fee Attached\$130  
check☐ Amendment / Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Response to Missing Parts/  
Incomplete Application☐ Response to Missing Parts  
under 37 CFR 1.52 or 1.53☐ Assignment Papers  
(for an Application)☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a  
Provisional Application☐ Power of Attorney, Revocation  
Change of Correspondence  
Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ After Allowance Communication  
to Group☐ Appeal Communication to Board  
of Appeals and Interferences☐ Appeal Communication to Group  
(Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s) (please  
identify below):  
see remarks**RECEIVED**

NOV 08 2002

Technology Center 2100

Remarks

Petition to Make Special; Statement in Support of Petition to  
Make Special; Statement of Facts in Support of Petition to Make  
Special; Attachments; Express Mail Certificate; Return Receipt  
Postcard

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm  
or  
Individual name

Karen Dana Oster

Signature

Date

11/05/2002

## CERTIFICATE OF MAILING

(see express mail)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class  
mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date:

11/05/2002

Typed or printed name

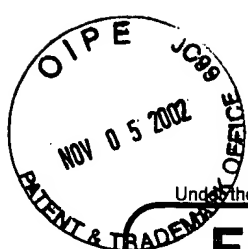
Karen Dana Oster

Signature

Date

11/05/2002

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments  
on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington,  
DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



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# FEE TRANSMITTAL for FY 2003

Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 130.00

## Complete if Known

Application Number 09/866,425  
Filing Date May 24, 2001  
First Named Inventor Vilcauskas et al.  
Examiner Name  
Art Unit 2176  
Attorney Docket No. Exit:PostSes

## METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 50-2115  
Deposit Account Name

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 740	2001 370	Utility filing fee	
1002 330	2002 165	Design filing fee	
1003 510	2003 255	Plant filing fee	
1004 740	2004 370	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1) (\$)			0

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	
Multiple Dependent	-3** =	X	

<u>Large Entity</u>		<u>Small Entity</u>		<u>Fee Description</u>
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	84	2201	42	Independent claims in excess of 3
1203	280	2203	140	Multiple dependent claim, if not paid
1204	84	2204	42	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1051 130	2051 65	Surcharge - late filing fee or oath
1052 50	2052 25	Surcharge - late provisional filing fee cover sheet
1053 130	1053 130	Non-English specification
1812 2,520	1812 2,520	For filing a request for ex parte reexamination
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action
1251 110	2251 55	Extension for reply within first month
1252 400	2252 200	Extension for reply within second month
1253 920	2253 460	Extension for reply within third month
1254 1,440	2254 720	Extension for reply within fourth month
1255 1,960	2255 980	Extension for reply within fifth month
1401 320	2401 160	Notice of Appeal
1402 320	2402 160	Filing a brief in support of an appeal
1403 280	2403 140	Request for oral hearing
1451 1,510	1451 1,510	Petition to institute a public use proceeding
1452 110	2452 55	Petition to revive - unavoidable
1453 1,280	2453 640	Petition to revive - unintentional
1501 1,280	2501 640	Utility issue fee (or reissue)
1502 460	2502 230	Design issue fee
1503 620	2503 310	Plant issue fee
1460 130	1460 130	Petitions to the Commissioner
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)
1806 180	1806 180	Submission of Information Disclosure Stmt
8021 40	8021 40	Recording each patent assignment per property (times number of properties)
1809 740	2809 370	Filing a submission after final rejection (37 CFR 1.129(a))
1810 740	2810 370	For each additional invention to be examined (37 CFR 1.129(b))
1801 740	2801 370	Request for Continued Examination (RCE)
1802 900	1802 900	Request for expedited examination of a design application

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 130.00

## SUBMITTED BY

(Complete if applicable)

Name (Print/Type) Karen Dana Oster  
Registration No. 37,621  
Telephone (503) 810-2560  
Signature  
Date 11/05/2002

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



CERTIFICATE UNDER 37 CFR 1.10  
CERTIFICATE OF MAILING BY  
"EXPRESS MAIL"

**RECEIVED**  
NOV 08 2002  
Technology Center 2100

Express Mail No.: EU069694899US  
Date of Deposit: November 5, 2002

I hereby certify that the following documents relating to a U.S. Patent Application No. 09/866,425 entitled Post-Session Internet Advertising Method and invented by Vilcauskas et al. are being deposited with the United States Postal Service, "Express Mail Post Office to Addressee" service under 37 CFR 1.10, on the date indicated above and is addressed to Commissioner for Patents, Washington, DC 20231.

- ☒ Transmittal Form PTO/SB/21
- ☒ Fee Transmittal Form and for \$130 for the petition fee
- ☒ Petition to Make Special
- ☒ Statement in Support of Petition to Make Special
- ☒ Statement of Facts in Support of Petition to Make Special & Attachments
- ☒ a return acknowledgement postcard
- ☒ this Certificate of Mailing by Express Mail

Karen Dana Oster



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
PATENT APPLICATION EXAMINING OPERATIONS

Applicants: Vilcauskas et al.

Group Art Unit: 2176

Serial No.: 09/866,425

Examiner:

Filed: May 24, 2001

Title: Post-Session Internet Advertising Method

PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT  
(37 C.F.R. § 1.102 AND M.P.E.P. § 708.02)

Law Office of Karen Dana Oster, LLC  
PMB 1020  
15450 SW Boones Ferry Rd. #9  
Lake Oswego, OR 97035  
November 5, 2002

Assistant Commissioner for Patents  
Washington, D.C. 20231

**RECEIVED**

NOV 08 2002

Dear Sir:

**Technology Center 2100**

Applicants hereby petition to make this application special because of actual infringement.

Accompanying this petition is a Statement of Facts in Support of Petition to Make Special Because of Actual Infringement and a Statement by Attorney in Support of Petition to make Special Because of Actual Infringement.

The fee required is to be paid by the attached check for \$130.00. The Commissioner is hereby authorized to charge any additional fee, or credit any overpayment, to Deposit Account No. 50-2115. A duplicate copy of this sheet is enclosed.

The person making this statement is the attorney who signs below on the basis of the information supplied by the inventor and the information in the file.

Respectfully submitted,

11/08/2002 NMOHAMM1 00000003 09866425

01 FC:1460

130.00 OP

Karen Dana Oster  
Reg. No. 37,621  
Of Attorneys of Record  
Tel: (503) 810-2560



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
PATENT APPLICATION EXAMINING OPERATIONS

Applicants: Vilcauskas et al.

Group Art Unit: 2176

Serial No.: 09/866,425

Examiner:

Filed: May 24, 2001

Title: Post-Session Internet Advertising Method

**RECEIVED**

NOV 08 2002

Technology Center 2100

STATEMENT IN SUPPORT OF PETITION TO MAKE SPECIAL  
BECAUSE OF ACTUAL INFRINGEMENT (M.P.E.P. § 708.02)

Law Office of Karen Dana Oster, LLC  
PMB 1020  
15450 SW Boones Ferry Rd. #9  
Lake Oswego, OR 97035  
November 5, 2002

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

I, Karen Dana Oster, whose address is Law Office of Karen Dana Oster (Reg. No. 37,621), LLC, PMB 1020, 15450 SW Boones Ferry Rd. #9, Lake Oswego, OR 97035, am the attorney of record for the above-referenced applicants, and make the following statements:

1. I have made a rigid comparison of the alleged infringing MSN Advantage Marketing "Pop-under Ad" method, GAIN "Backpage Pop-up" advertisement method, and ExitDirect<sup>SM</sup> pop-under advertisement method referred to in Andrew J. Vilcauskas Jr.'s STATEMENT OF FACTS IN SUPPORT OF PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT (M.P.E.P. § 708.02) with the claims of this application. My knowledge of these methods is based on information found at the websites and on information provided by Andrew J. Vilcauskas Jr.
2. In my opinion, claims 1-2, 4, 7-12, 15, and 17 on file in this application are unquestionably infringed by one or more of these methods.

3. By way of example, as pending claim 1 reads as follows:

"1. A post-session advertising system for use in a media having a background and a foreground, comprising the steps of:

- (a) displaying a first display in a first platform in said foreground of said media;
- (b) initiating a load triggering event;
- (c) opening a post-session platform in response to said load triggering event in said background of said media;
- (d) displaying a post-session display on said post-session platform; and
- (e) maintaining said post-session platform in said background until a viewer driven view triggering event occurs."

4. Based on representations by Andrew J. Vilcauskas Jr., the MSN Advantage Marketing "Pop-under Ad" method, GAIN "Backpage Pop-up" advertisement method, and ExitDirect<sup>SM</sup> pop-under advertisement method meet all of the limitations of claim 1.

5. Applicants have good knowledge of the pertinent prior art. Specifically, as indicated in his accompanying statement and in his May 24, 2001 Affidavit/Declaration, Andrew J. Vilcauskas Jr. has been working with computer technology on a full-time basis since 1988 and has been active on the Internet since 1995. As indicated in his May 24, 2001 Affidavit/Declaration, Robert D. Bloodgood III, the second inventor, has been working with computer technology on a full-time basis since 1981 and has been active on the Internet since 1995. As indicated in his May 24, 2001 Affidavit/Declaration, Matthew G. Middleton, the third inventor, has been working with computer technology on a full-time basis since 1983 and has been active on the Internet since 1994. As indicated in his May 24, 2001 Affidavit/Declaration, Bryan Hunter, Vice President of Sales of assignee ExitExchange Corporation, has been working with computer technology on a full-time basis since 1988 and has been active on the Internet since 1994. These people have made significant efforts to search for pertinent prior art that has been provided in respective Information Disclosure Statements.

6. Further, in the related PCT Application Serial No. PCT/US01/16980 having substantially identical claims to the present invention, the International Search Report listed only eleven references, all of which were indicated as being cited to define the general state of the art which is not considered to be of particular relevance. Many of these found references were published prior to the international filing date, but later than the priority date claimed by applicants.

7. All relevant information and prior art has been provided to the Examiner in an Information Disclosure Statement filed along with the original application as well as in Supplemental Information Disclosure Statements filed September 18, 2001, December 20, 2001, and August 24, 2002.

8. I believe all the claims in this application as on file are allowable over the art of which I am aware.

Respectfully submitted,

A handwritten signature in cursive script, reading "Karen Oster", is written over a horizontal line.

Karen Dana Oster  
Reg. No. 37,621  
Of Attorneys of Record  
Tel: (503) 810-2560



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
PATENT APPLICATION EXAMINING OPERATIONS

Applicants: Vilcauskas et al.                      Group Art Unit: 2176  
Serial No.: 09/866,425                      Examiner:  
Filed: May 24, 2001  
Title: Post-Session Internet Advertising Method

STATEMENT OF FACTS IN SUPPORT OF PETITION TO MAKE SPECIAL  
BECAUSE OF ACTUAL INFRINGEMENT (M.P.E.P. § 708.02)

Law Office of Karen Dana Oster, LLC  
PMB 1020  
15450 SW Boones Ferry Rd. #9  
Lake Oswego, OR 97035  
October 31, 2002

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

I, Andrew J. Vilcauskas Jr., whose address is 7305 SW Delaware Circle, Tualatin, OR 97062, am one of the inventors, and I hereby state the following:

1. There are actual infringements of this invention. Three exemplary actual infringements are detailed in this Statement; however, we are aware of many more instances of actual infringement.

2. MSN Advantage Marketing is specifically marketing an advertisement product called "Pop-under Ad." The description on the website describes the pop-under ad as "a non-user initiated ad type that is served "behind" all open Internet browser windows that the user may have open. Once visible, the user may interact with the fully functional, fully-navigable browser window, or they may choose to close it using the standard "x" close icon." I have personally reviewed "pop-under ad" advertisements provided by MSN Advantage Marketing. While I was in a first web page that was being displayed on a browser, I initiated a load triggering event. In response



to the load triggering event, a pop-under ad was opened in the background in a second browser. The second browser displaying the pop-under ad stayed in the background until I made a view triggering event. Based on my experience, I believe that this method infringes claim 1 of my currently pending patent application. Based on my experience and for similar reasons, I believe that this method infringes additional claims.

3. This MSN Advantage Marketing "Pop-under Ad" method that I allege infringes this invention was first discovered to exist on or about 8-8-02.

4. The Gator Corporation powers Gator Advertising and Information Network (GAIN) that delivers ads, information, and software based on the web sites a user views. One of its ad vehicles is "Backpage Pop-ups." This type of advertisement is a window that appears beneath other windows on the computer screen. There is also a demonstration of the backpage pop-ups ad vehicle. I have personally reviewed "backpage pop-up" advertisements provided by GAIN. While I was in a first web page that was being displayed on a browser, I initiated a load triggering event. In response to the load triggering event, a backpage pop-up was opened in the background in a second browser. The second browser displaying the backpage pop-up advertisement stayed in the background until I made a view triggering event. Based on my experience, I believe that this method infringes claim 1 of my currently pending patent application. Based on my experience and for similar reasons, I believe that this method infringes additional claims.

5. This GAIN "Backpage Pop-up" advertisement method that I allege infringes this invention was first discovered to exist on or about 9-2-02.

6. ExitDirect<sup>SM</sup> is specifically marketing an advertisement product called "Pop-under Ad." The description on the ExitDirect<sup>SM</sup> website describes how its pop-under ads work. "1. A surfer accesses your website, which has the ExitDirect<sup>SM</sup> code embedded on the page. 2. Upon your page fully loading, a sponsored ad will load BEHIND all active windows, leaving the surfer uninterrupted. 3. For each qualified hit you send to ExitDirect<sup>SM</sup> you will receive a minimum of 1X (and up to 2X) that amount of traffic from other ExitDirect<sup>SM</sup> affiliates." I have personally reviewed "pop-under ad" advertisements provided by ExitDirect<sup>SM</sup>. By opening a first web page to be

displayed on a browser, I initiated a load triggering event. In response to the load triggering event, a pop-under ad was opened in the background in a second browser. The second browser displaying the pop-under ad stayed in the background until I made a view triggering event. Based on my experience, I believe that this method infringes claim 1 of my currently pending patent application. Based on my experience and for similar reasons, I believe that this method infringes additional claims.

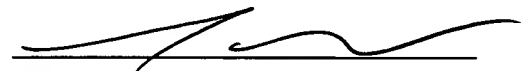
7. This ExitDirect<sup>SM</sup> pop-under advertisement method that I allege infringes this invention was first discovered to exist on or about 9-2-02.

8. The publication of this application and attempts to contact and negotiate with the infringers has failed to provide any satisfactory cessation of this infringement.

9. I have been working with computer technology on a full-time basis since 1988 and have been active on the Internet since 1995. Prior to my invention of the claimed invention, I had never seen the claimed combination.

I declare that all statements made herein are of my own knowledge, are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,



Andrew J. Vilcauskas Jr.

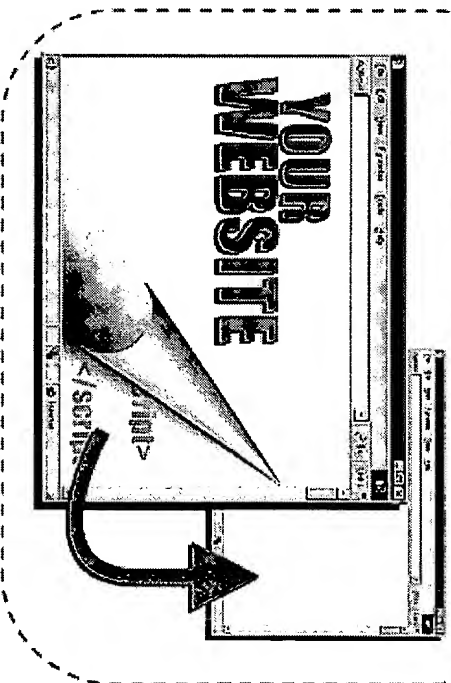
Address http://www.exitdirect.com/howitworks2.html



## ABOUT

- ☒ Embed ExitDirect Code
- ☒ Uninterrupted Surfing
- ☒ Get 100% Traffic Back!
- ☒ What are you waiting for?

**2** Upon your page fully loading, a sponsored ad will load **BEHIND** all active windows, leaving the surfer uninterrupted.



September 3, 2002

## services

- ☒ How does it work?
- ☒ FAQs
- ☒ Advertise
- ☒ Promote ExitDirect
- ☒ SIGNUP

## admin center

Username:

Password:

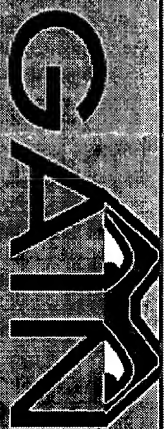
Login

press

08/01/2002

ExitDirect is still going strong!  
ExitDirect gives back on average  
130% more traffic back to its  
webmasters!

TOP ▲



We deliver advertisements in a variety of ways. Most GAIN ad delivery vehicles have their set of user preference settings. GAIN ad delivery vehicles may include:

- **Pop-Up Windows** appear as windows on top of or underneath other windows on computer desktop. Some are displayed in windows that float over other display at web pages you may be viewing.
- **Embedded Ads** are displayed within some GAINware applications.
- **Desktop icons and installation files** may be placed on your computer that link products and services.

Click here to see a demonstration of our current ad vehicles.

Many of the advertisements that we bring you are on behalf of advertisers who compete in company whose web page you may be viewing. Those advertisements will bear the GAIN brand to, among other reasons, make clear that our advertisers, and their products or services are not associated with, sponsored, or endorsed by the company whose web page you are viewing.

### Preference Settings.

If an ad vehicle has Preference Settings you can find and adjust them by clicking on the in the top right hand corner of the ad vehicle. See examples below.

**Pop up Ads look like this:**

Instant Offer - GAIN/Gator

**BIGTIME**

Click on the "?" to adjust the settings.

# BACKPAGE POP-UPS

Phil to do.doc

ExitExchange Documents

Outstanding Accounts.xls

r.txt

registry.reg

Casir Due

download.ofx

tile\_guy.txt

Built Worksh

### See entire story

In 2001, the average GAIN Instant Message delivered an 8% response rate. That's about 20 times greater than the average traditional banner ad.

The Gator Corporation is a greater source of new customers than MSN, AOL and Yahoo! for over 80% of our clients.

Ad Products

Ad Spec Finder

MSN Rich Media

Advertorial

Banner

Button

Content Module

E-mail - MSN Featured Offers

E-mail - WebCourier

E-mail Ad - Standard

E-mail Ad - Text

Exit Ad

Full Page Ad

Keystone Link

Listings

Mid-page Ad

News Alert

Package

Pop-under Ad

Pop-up Ad

Showcase Ad

Skyscraper

Small Banner

Sponsorship

Streaming: Audio

Streaming: Video

Text Link

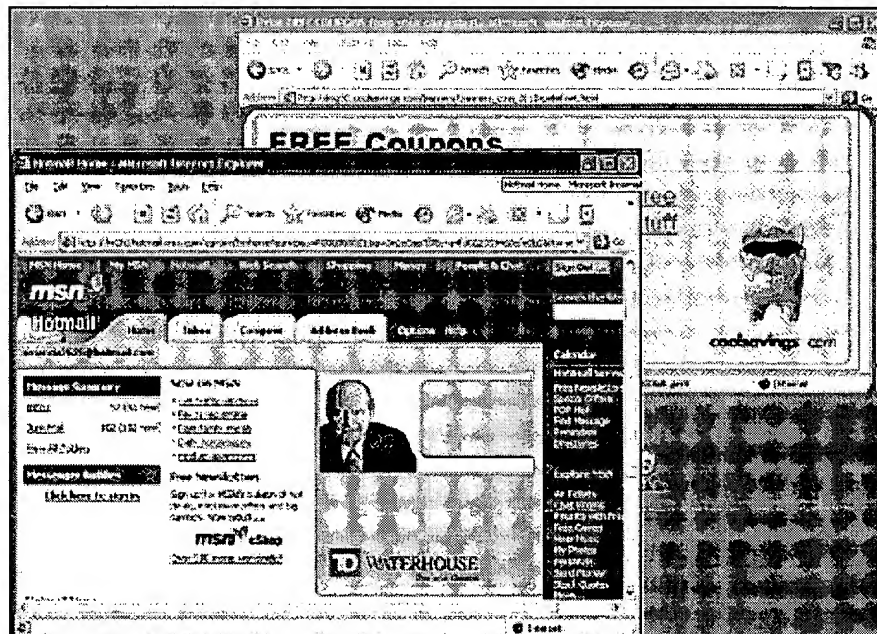
Transition Ad

Vertical Ad

## Pop-under Ad

### Description:

- The pop-under ad is a non-user initiated ad type that is served "behind" all open Internet browser windows that the user may have open. Once visible, the user may interact with the fully functional, fully-navigable browser window, or they may choose to close it using the standard "x" close icon. The pop-under ad window does not have an automatic close timeout feature. The user is effectively on the client's Web site at this time.
- The network-wide frequency control is set to once every 5 days.



### Benefits:

- Large dimensions allow for increased creative messaging options
- Strategically placed to deliver outstanding reach and a highly targeted audience
- User experience is carefully considered with MSN Pop-under ads; they only appear once every 7 days across the entire network - protecting your brand and consumer experience



"MSN 8 will be the most significant version of MSN we have ever released due to the thousands of hours of feedback we are gathering from people about their everyday problems using the Internet. Armed with this feedback, we are building MSN 8 to make the Web a more useful place."

**Yusuf Mehdi,**  
Vice President of MSN